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Docket No.: 432722002622	Atty: Laurie L. Hill/aeg
Serial No.: 09/421,545	Filing Date: October 20, 2001
Title: INHIBITORS OF PROTEASOMAL ACTIVITY FOR STIMULATING BONE GROWTH (AS AMENDED)	
VIA HAND DELIVERY ON NOVEMBER 19, 2002 via Courier	

Papers enclosed:

1. Transmittal (1 page)
2. Fee Transmittal (orig. & duplicate)
3. Amendment, including Exhibit A: Version with Markings of Changes Made (11 pages)
4. Exhibit B: Marcus, Robert, Agents Affecting Calcification and Bone Turnover, The Pharmacological Basis of Therapeutics, 1519, 1540 (Hardman, *et al.*, Eds., 1996)
5. Exhibit C: Copy of Declaration of Gregory R. Mundy (7 pages)
6. Exhibit D: Murray, *et al.*, Exp. Cell Res. 242: 460-9 (1 page)
7. Courtesy copies of previously cited references (70 references)
8. Combined Declaration & Power of Attorney, unsigned (3 pages)
9. Terminal Disclaimer (1 pages)
10. Petition for Correction of Inventor Name (2 pages)
11. Return Postcard

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Exhibit A

CERTIFICATE OF HAND DELIVERY

I hereby certify that this correspondence is being hand filed with the United States Patent and Trademark Office in Washington, D.C. on January 1/23, 2002.

Annette Masiello

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the application of:

Gregory R. Mundy, et al.

Serial Nos.: 09/113,947; 09/361,775;
09/421,545; 09/558,973 & 09/695,807

Filing Date:

For:

Examiner: R. Gitomer

Group Art Unit: 1623

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COMMUNICATION

Assistant Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

Applicant greatly appreciates the Examiner's granting an interview and discussing the outstanding issues in connection with the above-identified applications. The following lists items to be hand-delivered to the Examiner in connection with each of the above-identified applications.

09/113,947 (Docket No. 432722002600)

- Request for Reconsideration (including Exhibits A through F) sent to USPTO on October 19, 2001 via first class mail, on November 29, 2001 via hand-delivery and on January 2, 2002 via facsimile (without Exhibits A through E):

Exhibit A: U.S. Patent No. 6,083,690;

Exhibit B: U.S. Patent No. 6,022,887;

Exhibit C: WO 98/25460;

Exhibit D: Vinitsky, *et al.*, Inhibition of the Proteolytic Activity of the Multicatalytic Proteinase Complex (Proteasome) by Substrate-related Peptidyl Aldehydes, *J. Biol. Chem.* 269(47): 29860 (1994); and

Exhibit E: Application Serial No. 09/096,631.

09/361,775 (Docket No. 432722002620)

- Amendment and Response under 37 C.F.R. §1.116 (including Exhibits A through N) sent to USPTO on November 6, 2001 via hand-delivery, and a copy of a post card acknowledging USPTO's receipt of these references on November 6, 2001 is also included herein):

Exhibit A: A mark-up version of the amended claims 1-3;

Exhibit B: U.S. Patent No. 6,022,887

Exhibit C: U.S. Patent No. 6,117,887;

Exhibit D: U.S. Patent No. 6,075,150;

Exhibit E: U.S. Patent No. 5,847,076;

Exhibit F: Furet et al., *Bioorg. Med. Chem. Lett.*, 11(10):1321-4 (2001)

(Abstract only);

Exhibit G: Sunwoo et al., *Clin. Cancer Res.*, 7(5):1419-28 (2001) (Abstract only);

Exhibit H: Sun et al., *Cancer Res.*, 61(4):1280-4 (2001) (Abstract only);

Exhibit I: Princiotta et al., *Proc. Natl. Acad. Sci. U.S.A.*, 98(2):513-8 (2001) (Abstract only);

Exhibit J: U.S. Patent No. 6,207,458;

Exhibit K: Arnold et al., *J. Biol. Chem.*, 276(18):14675-84 (2001) (Abstract only);

Exhibit L: Sharma et al., *Bioorg. Med. Chem.*, 8(7):1819-23 (2000) (Abstract only);

Exhibit M: Ponnappan et al., *Exp. Gerontol.*, 34(1):95-107 (1999) (Abstract only); and

Exhibit N: Li et al., *J. Protein Chem.*, 17(8):757-63 (1998).

- references allegedly missing from the 3/13/00 IDS, namely References 1-4, 6, 9-25, 27-31, 33-41, 43-46, 48-59, 61-73, sent to USPTO on November 6, 2001 via hand-delivery (same references were also sent to USPTO on July 27, 2001 via first class mail with Amendment and Response under 37 C.F.R. §1.111, and a copy of a post card acknowledging USPTO's receipt of these references on August 1, 2001 is also included herein).

09/421,545 (Docket No. 432722002621)

- RESPONSE TO RESTRICTION REQUIREMENT AND PRELIMINARY AMENDMENT sent to USPTO on October 18, 2001 via first class mail.
- SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT UNDER 37 C.F.R. § 1.97 with the PTO-1449 Form and references 1 and 5-8 sent to USPTO on September 7, 2001 via first class mail.

09/558,973 (Docket No. 432722002622)

- RESPONSE TO RESTRICTION REQUIREMENT AND PRELIMINARY AMENDMENT sent to USPTO on October 19, 2001 via first class mail.
- SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT UNDER 37 C.F.R. § 1.97 with the PTO-1449 Form and references 1 and 5-8 sent to USPTO on September 7, 2001 via first class mail.

09/695,807 (Docket No. 432722002623)

- RESPONSE TO RESTRICTION REQUIREMENT sent to USPTO on December 17, 2001 via first class mail.
- INFORMATION DISCLOSURE STATEMENT UNDER 37 C.F.R. § 1.97 with the PTO-1449 Form and references 1, 10, 55, 63, 68 and 76 sent to USPTO on July 10, 2001 via first class mail.

In the unlikely event that the transmittal letter is separated from this document and the Patent Office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Assistant Commissioner to

charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing docket no. 432722002630. However, the Assistant Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

Respectfully submitted,

Dated: January 22, 2002

By: 

Peng Chen
Registration No. 43,543

Morrison & Foerster LLP
3811 Valley Centre Drive
Suite 500
San Diego, California 92130-2332
Telephone: (858) 720-5117
Facsimile: (858) 720-5125

CERTIFICATE OF MAILING VIA HAND-DELIVERY

I hereby certify that this correspondence is being HAND-DELIVERED to the : Assistant Commissioner for Patents, Washington, D.C. 20231, on
November 19, 2002.

Annette Masella

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#14
1/9/02
12/5/02

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the application of:

Gregory R. Mundy, et al.

Serial No.: 09/421,545

Filing Date: October 20, 1999

For: INHIBITORS OF PROTEASOMAL
ACTIVITY FOR STIMULATING BONE
[AND HAIR] GROWTH (AS
AMENDED)

Examiner: R. J. Gitomer

Group Art Unit: 1627

REQUEST FOR CORRECTION OF INVENTOR NAME

12/05/2002 GTRAHMEL 00000002 031952 09421545 PURSUANT TO 37 C.F.R. § 1.182

01 FC:1460

130.00 CH
Assistant Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

The presently named applicants, Gregory R. Mundy, *et al.*, hereby petitions the Assistant Commissioner to enter the Amendment of the application submitted herewith to provide a full name for the inventor G. Rossini. Enclosed are the following:

1. An oath or declaration by the actual inventor or inventors as required by § 1.63 or as permitted by §§ 1.42, 1.43 or § 1.47.

2. The written consent of any assignee.

3. The fee set forth in 37 C.F.R. § 1.17(h) of \$130.00.

- ☐ is enclosed
- ☒ is authorized to be charged to Deposit Account 03-1952. A Fee

Transmittal (form PTO/SB/17) is enclosed in duplicate for that purpose.

Applicant requests that the inventorship in the above-identified application be amended by adding the full first name of Jorge Gianni Rossini whose full first name was inadvertently omitted in the above application.

This request is supported by a Substitute Declaration, executed by Gregory R. Mundy, I. Ross Garrett, and Jorge Gianni Rossini. This amendment has been promptly filed as soon as the inadvertent typographical error was discovered in the above application.

The Patent and Trademark Office is respectfully requested to correct the inventorship and to enter the enclosed Substitute Declaration which has been executed by Gregory R. Mundy, I. Ross Garrett, and Jorge Gianni Rossini.

It is believed that applicant has complied with requirements and correction of the inventorship in the present application is respectfully requested.

Respectfully submitted,

Dated: November 18, 2002

By:


Laurie L. Hill

Registration No. (51,804)

Morrison & Foerster LLP
3811 Valley Centre Drive
Suite 500
San Diego, California 92130-2332
Telephone: (858) 720-7955
Facsimile: (858) 720-5125

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Please type a plus sign (+) inside this box → ☐

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PTO/SB/21 (08-00)
Approved for use through 10/31/02. OMB 0651-0031

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

Application Number	09/421,545
Filing Date	October 20, 1999
First Named Inventor	Gregory R. MUNDY, et al.
Group Art Unit	1627
Examiner Name	R. Gitomer
Attorney Docket No.	432722002621

Total Number Of Pages In This Submission **31**

ENCLOSURES (check all that apply)

- | | | |
|--|---|--|
| <input type="checkbox"/> Fee Transmittal Form | <input type="checkbox"/> Assignment Papers
(for an Application) | <input type="checkbox"/> After Allowance Communication to Group |
| <input type="checkbox"/> Fee Attached | <input type="checkbox"/> Drawing(s) | <input type="checkbox"/> Appeal Communication to Board of Appeals
and Interferences |
| <input checked="" type="checkbox"/> Amendment / Reply (including Exhibit
A: Version with Markings of Changes
Made) | <input type="checkbox"/> Licensing-related Papers | <input type="checkbox"/> Appeal Communication to Group
(Appeal Notice, Brief, Reply Brief) |
| <input type="checkbox"/> After Final | <input checked="" type="checkbox"/> Petition for Correction of
Inventor Name | <input type="checkbox"/> Proprietary Information |
| <input checked="" type="checkbox"/> Affidavits/declarations
(unsigned) (3 pages) | <input type="checkbox"/> Petition to Convert to a
Provisional Application | <input type="checkbox"/> Status Letter |
| <input type="checkbox"/> Extension of Time Request | <input type="checkbox"/> Power of Attorney, Revocation
Change of Correspondence
Address | <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): |
| <input type="checkbox"/> Express Abandonment Request | <input checked="" type="checkbox"/> Terminal Disclaimer | <input checked="" type="checkbox"/> Exhibit B: Marcus, Robert, Agents Affecting
Calcification and Bone Turnover, The
Pharmacological Basis of Therapeutics, 1519,
1540 (Hardman, et al. Eds., 1996) |
| <input type="checkbox"/> Information Disclosure Statement | <input type="checkbox"/> Request for Refund | <input checked="" type="checkbox"/> Exhibit C: Copy of Declaration of Gregory R.
Mundy pursuant to 37 C.F.R. § 1.132 |
| <input type="checkbox"/> Certified Copy of Priority Document(s) | <input type="checkbox"/> CD, Number of
CD(s) | <input checked="" type="checkbox"/> Exhibit D: Exhibit D: Murray, et al., Exp. Cell
Res. 242: 460-9 (1 page) |
| <input type="checkbox"/> Response to Missing Parts/
Incomplete Application | | <input checked="" type="checkbox"/> Courtesy copies of previously cited references |
| <input type="checkbox"/> Response to Missing Parts
under 37 CFR 1.52 or 1.53 | | |

Remarks



25225

PATENT TRADEMARK OFFICE

SIGNATURE OF APPLICANT, ATTORNEY OR AGENT

Firm or
Individual Name
Laurie L. Hill, (Reg No 51,804)
Morrison & Foerster LLP
3811 Valley Centre Drive - Suite 500
San Diego, CA 92130-2332

Signature

Laurie L. Hill

Date

November 18, 2002

CERTIFICATE OF MAILING VIA HAND-DELIVERY

I hereby certify that this correspondence is being HAND-DELIVERED to the : Assistant Commissioner for Patents, Washington, D.C. 20231, on November 19, 2002.

Annette Masella

Burden Hours Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Box Patent Application, Washington, DC 20231.

sd-119885

FEE TRANSMITTAL FOR FY 2002

Patent fees are subject to annual revision.

TOTAL AMOUNT OF PAYMENT

(\$ 185.00)

Complete if Known

Application Number 09/421,545
Filing Date October 20, 1999
First Named Inventor Gregory R. MUNDY, et al.
Examiner Name R.J. Gitomer
Group Art Unit 1627

Attorney Docket No. 432722002621

METHOD OF PAYMENT

1. ☒ The Commissioner is hereby authorized to charge indicated fees and credit any overpayments to:

Deposit Account Number 03-1952

Deposit Account Name Morrison & Foerster LLP

- ☒ Charge Any Additional Fee Required Under 37 CFR 1.16 and 1.17
☒ Applicant claims small entity status. See 37 CFR 1.27

2. ☐ Payment Enclosed:

☐ Check ☐ Credit Card ☐ Money Order ☐ Other

FEE CALCULATION

1. BASIC FILING FEE

Large Fee Code	Entity Fee (\$)	Small Fee Code	Entity Fee (\$)	Fee Description	Fee Paid
1001	740	201	370	Utility filing fee	
1002	330	206	165	Design filing fee	
1003	510	207	255	Plant filing fee	
1004	740	208	370	Reissue filing fee	
1005	160	214	80	Provisional filing fee	

SUBTOTAL (1) (\$ 0.00)

2. EXTRA CLAIM FEES

Total Claims	Extra Claims	Fee from below	Fee Paid
Independent Claims	- 20** =	x	= \$
Multiple Dependent	- 3** =	x	= \$

Large Fee Code	Entity Fee (\$)	Small Fee Code	Entity Fee (\$)	Fee Description
1202	18	203	9	Claims in excess of 20
1201	84	202	42	Independent claims in excess of 3
1203	280	204	140	Multiple dependent claims, if not paid
1204	84	209	42	**Reissue independent claims over original patent
1205	18	210	9	**Reissue claims in excess of 20 and over original patent

SUBTOTAL (2) (\$ 0.00)

** or number previously paid, if greater; For reissues, see above.

FEE CALCULATION (continued)

3. ADDITIONAL FEES

Large Fee Code	Entity Fee (\$)	Small Fee Code	Entity Fee (\$)	Fee Description	Fee Paid
1051	130	205	65	Surcharge - late filing fee or oath	
1052	50	227	25	Surcharge - late provisional filing fee or cover sheet	
1053	130	139	130	Non-English specification	
1812	2,520	147	2,520	For filing a request for ex parte reexamination	
1804	920*	112	920*	Requesting publication of SIR prior to Examiner action	
1805	1,840*	113	1,840*	Requesting publication of SIR after Examiner action	
1251	110	215	55	Extension for reply within first month	
1252	400	216	200	Extension for reply within second month	
1253	920	217	460	Extension for reply within third month	
1254	1,440	218	720	Extension for reply within fourth month	
1255	1,960	228	980	Extension for reply within fifth month	
1401	320	219	160	Notice of Appeal	
1402	320	220	160	Filing a brief in support of an appeal	
1403	280	221	140	Request for oral hearing	
1451	1,510	138	1,510	Petition to institute a public use proceeding	
1452	110	240	55	Petition to revive - unavoidable	
1453	1,280	241	640	Petition to revive - unintentional	
1501	1,280	242	640	Utility issue fee (or reissue)	
1502	460	243	230	Design issue fee	
1503	620	244	310	Plant issue fee	
1460	130	122	130	Petitions of the Commissioner	130
1807	50	123	50	Petitions related to provisional applications	
1806	180	126	180	Submission of Information Disclosure Stmt	
8021	40	581	40	Recording each patent assignment per properties (times number of properties)	
1809	740	246	370	Filing a submission after final rejection (37 CFR § 1.129(a))	
1810	740	249	370	For each additional invention to be examined (37 CFR § 1.129(b))	
1801	740	279	370	Request for Continued Examination (RCE)	
1802	900	169	900	Request for expedited examination of a design application	

Other fee (specify) Terminal Disclaimer under 37 C.F.R. § 3.73(b) 55

*Reduced by Basic Filing Fee Paid

SUBTOTAL (3) (\$ 185.00)

SUBMITTED BY

Name (Print/Type)

Laurie L. Hill

Registration No.
(Attorney/Agent)

51,804

Complete (if applicable)

Telephone

(858) 720-7955

Signature

Laurie L. Hill

Date

November 18, 2002

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.